

REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 9 and 16-18 are pending in the present application. Claims 9 and 16 are amended and Claim 18 is added by the present amendment.

In the outstanding Office Action, Claim 9 was rejected under 35 U.S.C. § 102(b) as anticipated by Plougsgaard et al. (U.S. Patent No. 6,091,604), herein “Plougsgaard”); Claims 9 and 17 were rejected under 35 U.S.C. § 103(a) as unpatentable over Plougsgaard in view of Japan '010 (Japanese Patent Application Publication No. 2000-196010); and Claim 16 was indicated as allowable if rewritten in independent form.

Applicants thank the Examiner for the indication of allowable subject matter in Claim 16. In view of this indication, Claim 16 has been rewritten in independent form to include the features of original Claim 9. No new matter is believed to be added. Thus, it is respectfully submitted that amended independent Claim 16 is allowable.

Applicants also thank the Examiner for the courtesy of an interview extended to Applicants’ representative on November 9, 2004. During the interview differences between the claims and the applied art were discussed. Further, clarifying claim amendments, similar to those presented herewith, were also discussed. The Examiner indicated he would further review the claim amendments in view of a filed response. Arguments presented during the interview are reiterated below.

The abstract has been replaced with a new abstract that is consistent with amended Claim 9. No new matter is believed to be added.

Regarding the rejection of Claim 9 under 35 U.S.C. § 102(b) as anticipated by Plougsgaard, Claim 9 is amended to more clearly recite a position of a smoothing capacitor

relative to a case frame. The claim amendment finds support for example in Figure 25. No new matter is believed to be added.

Briefly recapitulating, amended Claim 9 is directed to a power module that has a first substrate with a power semiconductor device mounted thereon, a second substrate with a control circuit for controlling the power semiconductor device from thereon, a smoothing capacitor electrically connected to the power semiconductor device, and a case including a case frame and a case lid. The case has an interior in which the first substrate, the second substrate, and the smoothing capacitor are disposed and the smoothing capacitor is disposed in contact with a side surface of the case frame.

In a non-limiting example, Figure 25 shows the first substrate 2, the second substrate 14, the smoothing capacitor 80, the case lid 16, and the case frame 6.

Turning to the applied art, Plougsgaard shows in Figure 1 a capacitor 4 formed in contact with a substrate 3 and the substrate 3 is placed in a housing 10 that has a lid 13. However, as discussed during the interview, Plougsgaard does not teach or suggest that the capacitor 4 is disposed in contact with a side surface of the housing 10. Accordingly, it is respectfully submitted independent Claim 9 and each of the claims dependent therefrom patentably distinguish over Plougsgaard.

Regarding the rejection of Claims 9 and 17 under 35 U.S.C. § 103(a) as unpatentable over Plougsgaard in view of Japan '010, Applicants note that this rejection addresses only Claim 17 and not independent Claim 9. Thus, Applicants consider that the above rejection is directed only to Claim 17, and the rejection of Claim 17 is addressed next.

The outstanding Office Action relies on Japan '010 for teaching a ceramic capacitor. However, Japan '010 does not overcome the deficiencies of Plougsgaard discussed above. In addition, Claim 17 depends from independent Claim 9, which is believed to be allowable as

noted above. Accordingly, it is respectfully submitted that dependent Claim 17 is also allowable.

New Claim 18 has been added to set forth the invention in a varying scope. Claim 18 depends from Claim 9 and finds support in the specification at page 27, lines 18-25. No new matter is believed to be added. Accordingly, it is respectfully submitted that dependent Claim 18 is allowable for similar reasons as discussed above.

Consequently, in light of the above discussion and in view of the present amendment, this application is believed to be in condition for allowance and an early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



Eckhard H. Kuesters  
Attorney of Record  
Registration No. 28,870

Customer Number  
**22850**

Tel: (703) 413-3000  
Fax: (703) 413 -2220  
(OSMMN 06/04)  
EHK/RFF:aif

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